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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/013,097	12/06/2001	Oliver Morgan	A00023(2)	9563

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PETER J. GORDON, PATENT COUNSEL
AVID TECHNOLOGY, INC.
ONE PARK WEST
TEWKSBURY, MA 01876

EXAMINER	
COLAN, GIOVANNA B	
ART UNIT	PAPER NUMBER
2162	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/013,097	MORGAN ET AL.	
	Examiner	Art Unit	
	Giovanna Colan	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is issued in response to the Amendment filed on 11/30/2006.

2. Claims 1, 4, 7, 8, 9, 19, 11, and 12 were amended. Claims 13 – 16 were canceled.

3. This action is made Final.

4. Claims 1 –12 are pending in this application.

5. Applicant's arguments with respect to amended claims 1, 4, 7, 8, 9, 19, 11, and 12 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 12/08/2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claims 1 and 4, the claimed subject matter, a system, does not contain a computer component (hardware). All the means plus functions as claimed are software per se. Without functional relationship between the claimed functions and any computer component, the system as claimed is not capable of producing tangible results and therefore not statutory.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1- 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick Berthold (Berthold hereinafter) ("Physical and Logical Integration of Data and Media Objects", 1998, pp. 143-161. URL: citeseer.ist.psu.edu/17071.html.) in view of Nguyen et al., "Nguyen" (U.S. Patent No. 6,119,130).

Regarding Claim 1, Berthold discloses a system ...comprising:

means for receiving the data stored using the stored using the second implementation (Page 145, and 146, Section 3: Interfaces of Component Systems, and Section: 3.4 II-AccessMM, Paragraph 2, and 1 and 2, "... All media objects can be downloaded..."; wherein the step of downloading corresponds to the sep of receiving claimed; and wherein Examiner interprets the interface AccessMM as the second implementation claimed; Berthold), wherein the data stored using the second implementation includes a data file comprising data describing media essence (Page 146, Section: 3.4 II-AccessMM, Paragraph 1, "image, graphic, audio, or video..."; Berthold), data describing metadata objects that reference the media essence (Page 150, Section 6.1: Object-Oriented Database Design, Paragraph 1 and 2, Figure 4, MediaPart, Berthold) and data describing the second implementation of the metadata schema (Page 151 and 152, Section 6.1.1: Modeling of Single Media Objects, text included in class1 and class3, "The definition of a class hierarchy (class1) has the

advantage that the media objects are grouped in classes according their real types which is directly supported by the management part of the component interface II-AccessMM..."; wherein Examiner interprets that if the real type, as disclosed in the prior art, is directly supported by the management part of the component interface II-AccessMM, then that real type has data describing the II-AccessMM; Berthold);

Berthold further discloses specifying an evolved property definition, for each object having a property in the first implementation (Page 151, Section 6.1.1: Modeling of Single Media Objects, "class 1 Definition of a class hierarchy with classes media type e.g. class SingleMediaObject and class Video). However, Berthold does not explicitly disclose the property in the first implementation that is different from a corresponding property of a corresponding object in the second implementation. On the other hand, Nguyen discloses: means for specifying an evolved property definition, for each object having a property in the first implementation that is different from a corresponding property of a corresponding object in the second implementation (See for example: col. 2 lines 56-58, "A mechanism is also provided for converting the data from the stored format to the expected format when the two formats do not match."; Nguyen).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Nguyen's teachings to the system Berthold. Skilled artisan would have been motivated to do so, as suggested by Nguyen (Col. 2, lines 35 – 43, Nguyen), to allow software to access data even when the format of the data is based on a different schema version than the schema version supported and expected by the software. In addition, both of the references (Berthold and Nguyen)

teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, databases management systems, property definition, and data format information. This close relation between both of the references highly suggests an expectation of success.

Furthermore, the combination of Berthold in view of Nguyen discloses:

means for adding the evolved property definition as a property of the object in the metadata schema in the data file (See for example: col. 5, lines 9-15, "Numerous applications 180 may access, update, and store data 188 through the data retrieval/update unit 182. The data retrieval/update unit 182 contains a data format conversion unit 184 for converting requested data from one format to another when the format expected by the requesting application (the "target format") does not match the format in which the data is actually stored (the "stored format")"; col. 6, line 66 – col. 7, lines 21, "The present invention includes a mechanism for tracking the formats associated with schema versions, and for providing the appropriate format information to the data format conversion unit 184. According to one embodiment of the invention, the data format information 194 includes all of the information for converting data between schema versions. Specifically, data format information 194 includes a schema version record for each version of each data type used to store data 188. For example, if data 188 includes an instance that was stored according to the format of a "type1" data type, then data format information 194 would include format information for all versions of the type1 data type. The schema version record for a particular schema version includes format data that describes all of the properties of the schema version,

including the attributes in the schema version and the type of data that is stored in each of the attributes. When a new version of a data type is created, a new schema version record is added to the data format information 194. The new schema version record includes format data that describes all of the attributes of the new version of the data type. The new schema version record is then associated with the existing schema version records that correspond to other versions of the same data type"; col. 8, lines 4-28, "As a **data type evolves from one version to the next, attributes may be added, deleted, or changed**. To accurately convert data between versions of a data type, a mechanism must be provided to indicate the correlation between a particular attribute and any corresponding attribute that appears in other versions of the same data type. According to one embodiment of the invention, the correlation between attributes of different versions is tracked by assigning each attribute a unique attribute identifier. When a new version of the data type is created, newly added attributes are assigned new attribute identifiers. However, existing attributes that have simply been modified in the new version of the data type maintain their attribute identifiers. For example, assume that the attributes "Type" and "Size" of the data type ENGINE1 have attribute identifiers 100 and 102, respectively. Assume also that in version 2 of the ENGINE data type the name of the "Type" attribute is changed to "Model", and a new attribute "Weight" is added. The new attribute "Weight" will be assigned a new unique attribute identifier. The Size attribute, which remains unchanged, will continue to have the attribute identifier 102. Because the "Model" attribute is a modification of the "Type" attribute, the "Model" attribute will have the same attribute identifier (i.e. 100) as the

"Type" attribute"; col. 10, lines 30-60, "When the expected format and the stored format do not match, then the data contained in an instance must be converted from the stored format to the target format before the data is supplied to the requesting application. According to one embodiment of the invention, data format conversion unit 184 performs the conversion process by **creating a target instance that corresponds to the stored instance**, but in which **the data is stored in the target format**.... For attributes that are present in both the target and stored formats, but that have been changed, conversion operations are performed to convert the data from the stored format to the target format. For example, if the target format specifies that an attribute holds a fixed point decimal value and the stored format specifies that the same attribute holds an integer, then **the integer that is stored in the attribute in the stored format is converted to a fixed point decimal value and stored in the target instance of the object**", Nguyen); and

means for using the evolved property definition to redirect accesses to a property in the first implementation to access the corresponding property in the data stored in the in the second implementation (See for example: col. 2 lines 38-43, wherein the means for using the evolved property definition to redirect accesses is inherent since the motivation of Nguyen is to provide a method and apparatus that allows software to access data even when the format of the data is based on a different schema version than the schema version supported and expected by the software; col. 2 line 46-48, "A method and apparatus that allow schema evolution to occur without requiring applications that expect older schemas to be recompiled is provided.", wherein the step

of redirecting accesses is also inherent; col. 53-58, wherein the evolved property definition being used to redirect access is inherent because the mechanism provided for converting the data from the stored format to the expected format corresponds to the claimed "evolved property definition", as defined in the applicant's specification page 7 lines 8-9, Nguyen).

Claim 2 is rejected for the reasons set forth hereinabove for claim 1 and furthermore the combination of Berthold in view of Nguyen discloses a system wherein the evolved property definition includes a reference to stored instructions for deriving a property in the first implementation from data stored in the second implementation (See for example: col. 2 lines 53-58; Fig. 1b "DATA FORMAT CONVERSION UNIT" and "STORED VERSION INFORMATION", Nguyen).

Claim 3 is rejected for the reasons set forth hereinabove for claim 1 and furthermore the combination of Berthold in view of Nguyen discloses a system wherein the means for specifying comprises:

means for accessing stored information describing the first implementation of the metadata schema and the second implementation of the metadata schema (See for example: col. 4 lines 61-66, Nguyen); and

means for determining a difference between the first implementation of the metadata schema and the second implementation of the metadata schema (See for example: col. 10 lines 30-60, Nguyen).

Regarding Claim 4, the combination of Berthold in view of Nguyen discloses a system ...comprising:

means for receiving the data stored using the stored using the second implementation (Page 145, and 146, Section 3: Interfaces of Component Systems, and Section: 3.4 II-AccessMM, Paragraph 2, and 1 and 2, "... All media objects can be downloaded..."; wherein the step of downloading corresponds to the step of receiving claimed; and wherein Examiner interprets the interface AccessMM as the second implementation claimed; Berthold), wherein the data stored using the second implementation includes a data file comprising data describing media essence (Page 146, Section: 3.4 II-AccessMM, Paragraph 1, "image, graphic, audio, or video..."; Berthold), data describing metadata objects that reference the media essence (Page 150, Section 6.1: Object-Oriented Database Design, Paragraph 1 and 2, Figure 4, MediaPart, Berthold) and data describing the second implementation of the metadata schema (Page 151 and 152, Section 6.1.1: Modeling of Single Media Objects, text included in class1 and class3, "The definition of a class hierarchy (class1) has the advantage that the media objects are grouped in classes according their real types which is directly supported by the management part of the component interface II-AccessMM..."; wherein Examiner interprets that if the real type, as disclosed in the prior art, is directly supported by the management part of the component interface II-AccessMM, then that real type has data describing the II-AccessMM; Berthold);

means for specifying a synthesized property definition for each object having a property in the first implementation for which a corresponding object in the second

implementation lacks a corresponding property (See for example: col. 10 lines 46-51, "For attributes that are present in the stored format that do not exist in the target format, no data is placed in the target instance. For attributes that are not present in the stored format but are present in the target format, user-defined default values or NULL values are stored in the target instance of the object. For example, a NULL string may be placed in the target instance for a string attribute that exists in the target format but not in the stored format.", Nguyen),

means for adding the synthesized property definition as a property of the object in the metadata schema in the data file (In the example above, the user-defined default values demonstrates that the synthesized property is being added to the target object to accept the user-defined default values, and also refer to the reasoning stated in claim 1 for the limitation including means for adding the property definition as a property of the object, Nguyen); and

means for maintaining information about accesses to the synthesized property definition (See for example: col. 5, lines 25-36, "According to one embodiment, the expected version of requested data is determined by the expected version determination unit 190 based on expected version information 186. The stored version of requested data is determined by the stored version determination unit 196 based on stored version information 198 stored with the data 188. The data format determination unit 192 determines the formats associated with the stored and expected schema versions based on data format information 194 maintained by the data format determination unit 192"; Figure 5, elements 520, 522, Nguyen).

Claim 5 is rejected for the reasons set forth hereinabove for claim 4 and furthermore the combination of Berthold in view of Nguyen discloses a system wherein the synthesized property definition includes a reference to stored instructions for deriving a property in the first implementation from data stored in the second implementation (See for example: col. 2 lines 53-58; Fig. 1b "DATA FORMAT CONVERSION UNIT", Nguyen).

Claim 6 is rejected for the reasons set forth hereinabove for claim 4 and furthermore the combination of Berthold in view of Nguyen discloses a system wherein the means for specifying comprises:

means for accessing stored information describing the first implementation of the metadata schema and the second implementation f the metadata schema (See for example: col. 4 lines 61-66, Nguyen);

means for determining a difference between the first implementation of the metadata schema and the second implementation of the metadata schema (See for example: col. 10 lines 30-33, Nguyen).

Claims 7-9 are rejected on grounds corresponding to the reasons given above for claims 1-3.

Claims 10-12 are rejected on grounds corresponding to the reasons given above for claims 4-6.

Response to Arguments

1. With respect to 35 USC § 101 rejection of claims 1- 6, applicant argues that; "the premise on which this rejection is based... is erroneous". Specifically, applicant argues that; "In particular, the claim elements recited in means-plus-function format must be constructed to cover "the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, sixth paragraph... Because computer hardware is describe as performing the recited functions (see description operation of this system in connection with Fig. 2), then the claim element cannot be constructed to be software per se and must be interpreted to include the computer hardware that uses the software to implement the recited function".

Examiner respectfully disagrees. First, as stated in the Office Action dated 08/04/2006, the claimed subject matter, a system, does not contain a computer component (hardware). All the means plus functions as claimed are software per se. Without functional relationship between the claimed functions and any computer component, the system as claimed is not capable of producing tangible results and therefore not statutory.

According to MPEP § 2106, C:

Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that

correspond to the recited function. Two en banc decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. § 112, sixth paragraph. In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc); In re Alappat, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (en banc).

Disclosure may be express, implicit, or inherent. Thus, at the outset, USPTO personnel must attempt to correlate claimed means to elements set forth in the written description that perform the recited step or function. The written description includes the original specification and the drawings and USPTO personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See Kemco Sales, Inc. v. Control Papers Company, Inc., 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Further guidance in interpreting the scope of equivalents is provided in MPEP § 2181 through § 2186.

Therefore, and to further clarify the Examiner's reasoning, applicant's specification in connection with Fig. 2, does not clearly link such means plus functions to all corresponding structures describe in the drawings, as recited in claims 1 and 4, to computer component (hardware).

2. As previously stated in Office Action dated 08/04/2006, in response to applicant's argument that the applied art fails to show certain features of applicant's invention, it is noted that the specific feature upon which applicant relies (for example, "**making any modifications** to a metadata schema...") is not recited in Claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

According to MPEP § 2106, C:

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). **Limitations appearing in the specification but not recited in the claim should not be read into the claim**. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d

1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320,

1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear,

correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." Multiform Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

3. Applicant argues that the prior art fails to disclose the amended limitation; "the data stored using the second implementation includes a data file comprising data describing media essence, data describing metadata objects that reference the media essence and data describing the second implementation of the metadata schema".

Examiner respectfully disagrees. The applied art does disclose the amended limitation: the data stored using the second implementation includes a data file comprising data describing media essence, data describing metadata objects that reference the media essence and data describing the second implementation of the metadata schema (See – 35 USC § 103 rejection of claims 1, 4, 7, and 10 discussed in this Office Action above).

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Prior Art Made Of Record

1. Henrick Berthold (Berthold hereinafter) ("Physical and Logical Integration of Data and Media Objects", 1998, pp. 143-161. URL: citeseer.ist.psu.edu/17071.html.).

2. Nguyen et al., "Nguyen" (U.S. Patent No. 6,119,130).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna Colan whose telephone number is (571) 272-2752. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Giovanna Colan
Examiner
Art Unit 2162
April 14, 2007

John E. Breene
JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100